

REMARKS

This is in response to the Office Action that was mailed on December 15, 2004. Claim 17 is amended to expedite the prosecution of this application. Specifically, the term “monochromatic” is deleted from the claim, the term “comprising” is replaced by the language “consisting essentially of”, the clause “and free from a dye forming coupler” is deleted from the claim, and the claim 22 definition of formula (1) is incorporated into claim 17. Claims 18-22 are cancelled, without prejudice. No new matter is introduced by this Amendment, and no new issues are raised thereby. Entry of this Amendment – in order to place the application into condition for allowance or into better condition for appeal – is respectfully solicited. With this Amendment, claims 17 and 23-27 are pending in the application.

Rejection of Claims 17-27 under 35 U.S.C. §112

Claims 17-27 were rejected under 35 U.S.C. §112, first paragraph, for reasons set forth on pages 2-3 of the Office Action. The Examiner argued that the specification fails to provide support for the claim language “free from a dye-forming coupler”. The Examiner has also stated a related rejection, under the second paragraph of 35 U.S.C. §112, on page 3 of the Office Action. The rejections are respectfully traversed.

An application need not contain a word-for-word description of the claimed invention to satisfy the written description requirement. All that is required is that the application reasonably convey the claimed subject matter to those skilled in the art. This point is illustrated in *Ex parte Parks*, 30 USPQ2d 1234 (B.P.A.I. 1994). In *Parks*, the invention related to a method of determining the nitrogen content of a sample by decomposing it. After the application was filed,

the applicant inserted into the claims the recitation that the decomposition was conducted “in the absence of a catalyst”. The application contained no statement at all with respect to the use of a catalyst to speed up the decomposition.

The Board reversed the Examiner’s rejection of the amended claims, stating that

[t]he examiner contends that the rejected claims lack adequate descriptive support because there is “no literal basis for the” claim limitation “in the absence of a catalyst.” Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.

30 USPQ2d at 1236. The Board noted that the originally filed disclosure would have conveyed to one of ordinary skill in the art the concept of conducting the decomposition without the use of a catalyst. The Board indicated that the disclosure described several examples of the decomposition process without the mention of a catalyst, even though “the discussion would seem to cry out for a catalyst if one were used.” 30 USPQ2d at 1236. The Board was therefore of the opinion that the original description adequately supported the decomposition process without the presence of a catalyst and that the Examiner had failed to provide a *prima facie* case of lack of adequate written description.

Similarly, in the present situation, Applicants respectfully maintain that the Examiner has failed to state a *prima facie* case that the language “free from a dye-forming coupler” is not adequately supported by the disclosure herein. Nevertheless, in the spirit of compact prosecution, the present Amendment deletes the language in question from the claims, thereby rendering moot this ground of rejection.

Rejection of Claims 17-22 and 25-27 under 35 U.S.C. §103(a)

Claims 17-22 and 25-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over either Takeuchi or Nakamura in view of the combination of Cerquone and EP '196 and Shoei. Office Action, pages 4-5. Claims 23-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takeuchi or Nakamura in view of JP '934. These rejections are not applicable to the claims as amended herein.

The compounds represented by formula (1) as it is defined in claim 17 in its present form are neither taught nor suggested by the cited prior art, alone or in combination. Those references which employ a dye-forming coupler do not impact the present claims because they are excluded by the "consisting essentially of" language in the present claims. Reconsideration and withdrawal of the rejections of record is respectfully requested.

In order to follow through on previous prosecution in this application, Applicants reiterate the following observations:

Applicants respectfully disagree with the Examiner's previous assertion that the skilled artisan would "pick and choose" any one color from Table 1 of Takeuchi. The Examiner may not properly use hindsight to "pick and choose" any one color from a variety of colors. Indeed, modifying the teachings of the prior art in the manner suggested by the Examiner would destroy the teachings thereof or change the principle of operation of the reference. This has been held to be improper. See e.g. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); *In re Ratti*, 123 USPQ 349 (CCPA 1959).

The phenol compounds of the present invention work as a reducing agent for silver salt, whereas the phenol compounds of Cerquone react with silver halide to form a dye. The

Examiner has acknowledged that the phenol compounds of Cerquone do not perform the same function as those of the present invention. However, the Examiner has pointed to the last paragraph in column 67 of Takeuchi as evidence that the phenol compounds could be used for both functions. The Examiner has employed impermissible hindsight, "picking and choosing" from the teachings of the prior, in an attempt to suggest the present invention. Such modification, unwarranted by the disclosure of the Cerquone reference, is improper. Compare *Carl Schenck, A.G. v. Norton Corp.*, 218 USPQ 698 (Fed. Cir. 1983).

With regard to the data disclosed in the 'Declaration under 37 CFR 1.132' of Mr. Toyohisa OYA, filed herein on October 6, 2003, the Examiner's attention is respectfully directed to the first paragraph on page 6 thereof. Mr. Oya explicitly states that Sample No. 704 having a (D-119)/(D-1) ratio of more than 10% is not practical due to the strong fog whereas Samples Nos. 702 and 703 having a (D-119)/(D-1) ratio of the claimed range showed improvement of sensitivity and low fog. Mr. Oya further states that this result indicates that the range of 0.1 mole % to 10 mole % is critical in the claimed invention and the criticality is not predictable from the cited references. Thus, Mr. Oya clearly indicates that the difference is significant and the results are unexpected. It is respectfully submitted that the Examiner is obligated to consider this factual evidence.

In summary, the Examiner has failed to establish a *prima facie* case of obviousness. Assuming, arguendo, that the Examiner had established a *prima facie* case of obviousness against the claims in their previous form (a point not conceded by Applicants), the Examiner should note that the Declaration evidence of record clearly rebuts any *prima facie* case of obviousness. Thus, the prior art rejections should be withdrawn by the Examiner.


Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

RG By 

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